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HENKEL CORPORATION THE TRIAD, SUITE 200 2200 RENAISSANCE BLVD. GULPH MILLS, PA 19406			ROSSI, JESSICA	
			ART UNIT	PAPER NUMBER
			1733	

DATE MAILED: 05/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/877,372

Applicant(s)

SCHOLZ, KONRAD

Examiner

Jessica L. Rossi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 3/22/06, Amendment.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 19-34 is/are pending in the application.
- 4a) Of the above claim(s) 26 and 28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 19-25, 27, 29-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Response to Amendment*

1. This action is in response to the amendment dated 3/22/06. Claims 1-18 were cancelled. Claims 19-34 were added. Claims 26 and 28 remain withdrawn from further consideration as being drawn to non-elected Species, as set forth in paragraph 5 of the previous action dated 12/29/05.

### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 19-32 and 34 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

With respect to claims 19 and 34, the present specification does not have support for the spring steel band being attached to the sliding shoe *only in the region that first engages the covering*. The specification discloses the ‘region that first engages the covering’ as being the **rounded part** of “entry zone” 9 of the spring steel band 30, as shown in Figure 1 – clearly the rounded part of the entry zone is not attached to the sliding shoe 31. Applicant is asked to clarify.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 19-32 and 34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claims 19 and 34, it is unclear what Applicant means by the spring steel band being attached to the sliding shoe only in the region that first engages the covering. See new matter rejection above. Applicant is asked to clarify.

Also regarding claims 19 and 34, they recite the limitation "the region" in lines 6 and 9, respectively. There is insufficient antecedent basis for this limitation in the claim. It is suggested to change "the region" to --a region--.

***Claim Rejections - 35 USC § 102***

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. Claims 19, 22-24, 27, 30 and 33 are rejected under 35 U.S.C. 102(b) as being anticipated by Werz (GB 1050517).

With respect to claim 33, Werz teaches a method of adhering a covering 21 to an edge of a workpiece 22 comprising the steps of providing a sliding shoe having a spring steel band 20, placing the covering 21 between the spring steel band and the workpiece edge, and pressing the covering onto the workpiece edge by slidably engaging the covering with the spring steel band along the longitudinal axis of the workpiece (Figure 5; p. 1, lines 11-16; p. 2, lines 70-75; p. 3, lines 105-116).

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With respect to claim 19, all the limitations were addressed with respect to claim 33, except the spring steel band being attached to the sliding shoe only in the region that first engages the covering. Werz teaches such (Figure 5).

Regarding claims 22-24, 27 and 30, Werz teaches such (p. 1, lines 11-16; p. 2, lines 10-16).

8. Claims 19-24, 27, 30 and 33-34 are rejected under 35 U.S.C. 102(b) as being anticipated by Kohler (US 2970619).

With respect to claim 33, Kohler teaches a method of adhering a covering (strip of veneer) to an edge of a workpiece (elongated wood board) comprising the steps of providing a sliding shoe having a spring steel band 62, placing the covering between the spring steel band and the workpiece edge, and pressing the covering onto the workpiece edge by slidably engaging the covering with the spring steel band along the longitudinal axis of the workpiece (Figures 1-2; column 1, lines 15-28 and 64-70; column 2, lines 1-6; column 2, lines 55-57 and column 2, line 69 – column 3, line 3; column 3, lines 42-44 and 59-63; column 5, lines 3-6; **column 5, lines 55-60; column 6, line 19**).

With respect to claim 19, all the limitations were addressed with respect to claim 33, except the spring steel band being attached to the sliding shoe only in the region that first engages the covering. Kohler teaches such.

Regarding claims 20-21, Kohler teaches such (Figures 1-2; column 3, line 22 – column 5, line 2).

Regarding claim 22, Kohler teaches such.

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Regarding claims 23-24, Kohler teaches such (column 2, lines 55-57; column 5, lines 3-6).

Regarding claim 27, Kohler teaches such (column 1, lines 15-19; column 2, lines 55-57).

Regarding claim 30, Kohler teaches such (column 2, lines 1-6).

Regarding claim 34, all the limitations were addressed above with respect to claims 19-21, except engaging the covering with the roller along the longitudinal axis of the workpiece. Kohler teaches such (Figures 1-2; column 3, line 22 – column 5, line 2).

***Claim Rejections - 35 USC § 103***

9. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

10. Claims 20-21 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Werz as applied to claim 19 above and further in view of Duewel (US 4222812).

Regarding claims 20-21, Werz is unclear as to whether the covering is engaged with a roller. It would have been obvious to supply the covering in roll-form such that the covering is engaged by the roller and unwound therefrom prior to it being pressed onto the workpiece edge because such is known in the art, as taught by Duewel (Figure 1; column 3, lines 35-36), where this allows for easy storage of the covering and the execution of a continuous process if so desired.

With respect to claim 34, all the limitations were addressed above with respect to claims 19-21, except engaging the covering with the roller along the longitudinal axis of the workpiece. *It is noted that this language does not limit the claim to the roller pressing the covering onto the workpiece*; therefore, it would have been obvious to place the roller along the edge of the

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workpiece, upstream from the sliding shoe, such that the covering moves along the longitudinal axis of the workpiece as the engaging roller unwinds the covering because this minimize the area occupied by the apparatus.

11. Claims 25 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Werz as applied to claim 19 above.

Regarding claims 25 and 29, selection of particular dimensions for the board and covering would have been with purview of one having ordinary skill in the art.

12. Claims 25, 29 and 31-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kohler as applied to claim 19 above.

Regarding claims 25 and 29, selection of particular dimensions for the board and covering would have been with purview of one having ordinary skill in the art.

Regarding claims 31-32, selection of a type of adhesive would have been within purview of one having ordinary skill in the art.

13. Claims 19-25, 27 and 29-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Curran et al. (US Re. 23,572, of record) in view of the collective teachings of Kohler, Werz, Bielfeldt (US 5454304) and Monaco et al. (US 2993523).

With respect to claim 33, Curran teaches a method of adhering a covering 1a to an edge of a workpiece 1 comprising the steps of providing a sliding shoe 5 having a flexible band 6, placing the covering between the band and the workpiece edge, and pressing the covering onto the workpiece edge by slidably engaging the covering with the band along the longitudinal axis of the workpiece (Figures 1-2; column 1, lines 3-10; column 2, lines 50-55; column 3, lines 35-

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37 and 60-61; column 4, lines 1-7 and 12-20). It is unclear as to whether the flexible band is spring steel.

One reading the reference would have appreciated that a particular type of flexible material for the band is not critical to the invention (column 3, lines 35-37); therefore, it would have been obvious to use a flexible spring steel band because such is used in a variety of arts, including the art of bonding veneer coverings to the edges of a workpiece, as a flexible member for applying pressure to a substrate to bond it to another substrate, as taught by the collective teachings of Kohler (Figure 1; column 1, lines 15-28 and 64-70; column 2, lines 1-6; column 2, lines 55-57 and column 2, line 69 – column 3, line 3; column 3, lines 42-44 and 59-63; column 5, lines 3-6; **column 5, lines 55-60; column 6, line 19**), Werz (p. 2, lines 115-120), Bielfeldt (abstract; column 3, lines 18-21) and Monaco (column 1, lines 15-16 and 59-60; column 3, lines 52-60).

With respect to claim 19, all the limitations were addressed with respect to claim 33, except the spring steel band being attached to the sliding shoe only in the region that first engages the covering. Curran teaches such.

Regarding claims 20-21, Curran is unclear as to whether the covering is engaged with a roller. It would have been obvious to supply the veneer covering of Curran such that a roller engages the covering prior to it being pressed onto the workpiece edge by a steel band because such is known in the art, as taught by Kohler (Figure 1; column 1, lines 15-28 and 64-70; column 2, lines 1-6; column 2, lines 55-57 and column 2, line 69 – column 3, line 3; column 3, lines 42-44 and 59-63; column 5, lines 3-6; **column 5, lines 55-60; column 6, line 19**), where this allows



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for easy storage and removal of the covering and the execution of a continuous process if so desired.

Regarding claims 22-23, 27 and 30, Curran teaches such (column 1, lines 3-12 and 50-55; column 2, lines 1-6).

Regarding claim 24, selection of a particular material for the board of Curran would have been within purview of one having ordinary skill in the art; however, it would have been obvious to use a wood board because it is known in the art to apply veneer coverings to the edges of wood boards, as taught by Kohler (column 1, lines 15-28; column 5, lines 3-6).

Regarding claims 25 and 29, selection of particular dimensions for the board and covering would have been within purview of one having ordinary skill in the art.

Regarding claims 31-32, selection of a type of adhesive would have been within purview of one having ordinary skill in the art.

With respect to claim 34, all the limitations were addressed above with respect to claims 19-21, except engaging the covering with the roller along the longitudinal axis of the workpiece. Curran in view of Kohler teaches such (see Figure 1 of Kohler).

14. Claims 20-21 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Curran et al. in view of the collective teachings of Kohler, Werz, Bielfeldt and Monaco et al. as applied to claim 19 above, and further in view of Duewel.

\*The following are alternative rejections to that set forth in the previous paragraph:

Regarding claims 20-21, Curran is unclear as to whether the covering is engaged with a roller. It would have been obvious to supply the covering in roll-form such that the covering is engaged by the roller and unwound therefrom prior to it being pressed onto the workpiece edge

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because such is known in the art, as taught by Duewel (Figure 1; column 3, lines 35-36), where this allows for easy storage of the covering and the execution of a continuous process if so desired.

With respect to claim 34, all the limitations were addressed above with respect to claims 19-21, except engaging the covering with the roller along the longitudinal axis of the workpiece. *It is noted that this language does not limit the claim to the roller pressing the covering onto the workpiece*; therefore, it would have been obvious to place the roller along the edge of the workpiece, upstream from the sliding shoe, such that the covering moves along the longitudinal axis of the workpiece as the engaging roller unwinds the covering because this minimize the area occupied by the apparatus.

15. Claims 19, 22-25, 27 and 29-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tarnok (US 3190783) in view of the collective teachings of Kohler, Werz, Bielfeldt and Monaco et al.

With respect to claim 33, Tarnok teaches a method of adhering a covering 60 to an edge 64 of a workpiece 66 comprising the steps of providing a sliding shoe 10 having a flexible band 40, placing the covering between the band and the workpiece edge, and pressing the covering onto the workpiece edge by slidably engaging the covering with the band along the longitudinal axis of the workpiece (Figures 1 and 12; column 1, lines 7-11 and 35-40; column 2, lines 59-61; column 3, lines 25-35 and 49-51). It is unclear as to whether the flexible band is spring steel.

One reading the reference would have appreciated that a particular type of flexible material for the band is not critical to the invention; therefore, it would have been obvious to use a flexible spring steel band because such is used in a variety of arts, including the art of bonding

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plastic and veneer coverings to the edges of a workpiece, as a flexible member for applying pressure to a substrate to bond it to another substrate, as taught by the collective teachings of Kohler (Figure 1; column 1, lines 15-28 and 64-70; column 2, lines 1-6; column 2, lines 55-57 and column 2, line 69 – column 3, line 3; column 3, lines 42-44 and 59-63; column 5, lines 3-6; **column 5, lines 55-60; column 6, line 19**), Werz (p. 2, lines 115-120), Bielfeldt (abstract; column 3, lines 18-21) and Monaco (column 1, lines 15-16 and 59-60; column 3, lines 52-60).

With respect to claim 19, all the limitations were addressed with respect to claim 33, except the spring steel band being attached to the sliding shoe only in the region that first engages the covering. Tarnok teaches such.

Regarding claims 22-23 and 27, Tarnok teaches such (column 1, lines 7-11).

Regarding claim 24, selection of a particular material for the board of Tarnok would have been within purview of one having ordinary skill in the art; however, it would have been obvious to use a wood board because it is known in the art to apply veneer coverings to the edges of wood boards, as taught by Kohler (column 1, lines 15-28; column 5, lines 3-6).

Regarding claims 25 and 29, selection of particular dimensions for the board and covering would have been within purview of one having ordinary skill in the art.

Regarding claims 30-32, it would have been obvious to apply the covering of Tarnok using adhesive because such is known in the art, as taught by Kohler (column 2, lines 1-6), where this ensures a good bond between the covering and workpiece. Selection of a particular type of adhesive would have been within purview of one having ordinary skill in the art.

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16. Claims 20-21 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tarnok and the collective teachings of Kohler, Werz, Bielfeldt and Monaco et al. as applied to claim 19 above, and further in view of Duewel.

Regarding claims 20-21, Tarnok is unclear as to whether the covering is engaged with a roller. It would have been obvious to supply the covering in roll-form such that the covering is engaged by the roller and unwound therefrom prior to it being pressed onto the workpiece edge because such is known in the art, as taught by Duewel (Figure 1; column 3, lines 35-36), where this allows for easy storage of the covering and the execution of a continuous process if so desired.

With respect to claim 34, all the limitations were addressed above with respect to claims 19-21, except engaging the covering with the roller along the longitudinal axis of the workpiece. *It is noted that this language does not limit the claim to the roller pressing the covering onto the workpiece*; therefore, it would have been obvious to place the roller along the edge of the workpiece, upstream from the sliding shoe, such that the covering moves along the longitudinal axis of the workpiece as the engaging roller unwinds the covering because this minimize the area occupied by the apparatus.

17. Claims 19-25, 27 and 29-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Held (GB 2104448) in view of the collective teachings of Kohler, Bielfeldt and Monaco et al.

With respect to claim 33, Held teaches a method of adhering a covering 10 to an edge of a workpiece comprising the steps of providing a sliding shoe 7 having a flexible band, placing the covering between the band and the workpiece edge, and pressing the covering onto the

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workpiece edge by slidably engaging the covering with the band along the longitudinal axis of the workpiece (Figure 2; p. 1, lines 67-72 and 119-120; p. 2, lines 7-12; p. 2, line 64 – p. 3, line 68). It is unclear as to whether the flexible band is spring steel.

One reading the reference would have appreciated that a particular type of flexible material for the band is not critical to the invention; therefore, it would have been obvious to use a flexible spring steel band because such is used in a variety of arts, including the art of bonding coverings to the edges of a workpiece, as the flexible member of a sliding shoe that applies pressure to a substrate to bond it to another substrate, as taught by the collective teachings of, Kohler (Figure 1; column 1, lines 15-28 and 64-70; column 2, lines 1-6; column 2, lines 55-57 and column 2, line 69 – column 3, line 3; column 3, lines 42-44 and 59-63; column 5, lines 3-6; **column 5, lines 55-60; column 6, line 19**), Bielfeldt (abstract; column 3, lines 18-21) and Monaco (column 1, lines 15-16 and 59-60; column 3, lines 52-60).

With respect to claim 19, all the limitations were addressed with respect to claim 33, except the spring steel band being attached to the sliding shoe only in the region that first engages the covering. Held teaches such.

Regarding claims 20-21, Held teaches such; note rollers 9 (Figure 2).

Regarding claim 22, Held teaches such (Figure 2).

Regarding claims 23-24, held teaches such (p. 2, lines 53-55).

Regarding claims 25 and 29, selection of particular dimensions for the board and covering would have been with purview of one having ordinary skill in the art.

Regarding claim 27, Held teaches such (p. 1, lines 67-72).

Regarding claim 30, Held teaches such (p. 2, lines 7-12).

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Regarding claims 31-32, selection of a particular type of adhesive would have been within purview of one having ordinary skill in the art.

Regarding claim 34, all the limitations were addressed above with respect to claims 19-21, except engaging the covering with the roller along the longitudinal axis of the workpiece. Held teaches such (Figure 2).

#### *Allowable Subject Matter*

18. The examiner hopes that the multiple rejections set forth in the previous action allow Applicant to appreciate how broadly the present claims can be construed. To possibly put the case in condition for allowance, it is suggested that Applicant amend the independent claims such that they claim exactly what is depicted in Figure 1 while **also** claiming all of the features of the 'sliding shoe' exactly as depicted in Figures 1 and 2.

#### *Conclusion*

19. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Jessica L. Rossi** whose telephone number is **571-272-1223**. The examiner can normally be reached on M-F (8:00-5:30) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard D. Crispino can be reached on 571-272-1226. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

**JESSICA ROSSI**  
**PRIMARY EXAMINER**

